



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,570	11/21/2001	John M. Fenderson	38867/240561	2661

826 7590 10/20/2003

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

CLARDY, S

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 10/20/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/990,570

Applicant(s)
Fenderson et al

Examiner
S. Mark Clardy

Art Unit
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 3, 2002, and Petition Grant on March 13, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/236,732.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

Art Unit: 1616

Claims 1- 24 are pending in this reissue application, filed November 21, 2001, from US Patent 5,990,046 (SN 08/911,926, issued November 23, 1999), with claims drawn to herbicidal compositions comprising dimethenamid + triketone/dione herbicides, optionally further comprising a triazine herbicide. The '046 patent is a division of US 5,716,901, filed as application SN 08/467,364 (claims drawn to dimethenamid + sulcotrione + atrazine), which is a continuation of SN 08/265,594, abandoned, which is a continuation in part of US 5,877,115 (dimethenamid + dicamba, filed as SN 08/236,762). Claims in the related applications¹ as noted in the parent application are drawn to combinations of dimethenamid and other different secondary herbicides.

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Applicants are requested to provide an IDS listing all of the references cited in the parent patent.

Claims 1-6, 10, and 11 have been amended and new claims 14-24 added in order to specifically recite compositions comprising dimethenamid + triazine herbicides (with no triketone/dione herbicides present), in addition to the compositions in the '046 patent.

A brief history of the prosecution follows, beginning with SN 08/265,594. Abbreviations used herein are: D=dimethenamid, S= sulcotrione (a triketone herbicide), A=atrazine (a triazine herbicide).

¹ 08/911,645	08/911,715	08/911725	08/911,911	08/911,926	08/912,087
08/912,124	08/912,134	08/912,444	08/912,449	08/914,349	08/914,799

Art Unit: 1616

In application 08/265,594, claims were originally drawn to compositions (claim 10) and methods of use (claim 1) comprising D in combination with at least one other herbicide and a carrier. In response to a telephonic restriction requirement, applicants elected the species comprising D+A. Claims to this species were then rejected over a combination of references. Applicants were informed that the rejection did not apply to the combination of D+A+S or D+chlorimuron(+diuron). This application then was abandoned in favor of SN 08/467,364.

The requirement to elect a species was not repeated in 08/467,364, but the rejection was repeated. Applicants subsequently limited the claims to the subject matter which had previously been indicated as being allowable (i.e., D+A+S), and the application was allowed as US Patent 5,716,901.

Application 08/911,926 was filed as a divisional of the '901 patent, with claims drawn to compositions comprising D in combination with a dione or triketone herbicide such as S, optionally further comprising a triazine such as A. The claims were found allowable in response to a declaration presenting evidence of unexpected synergistic results for D+S as well as D+mesotrione (another triketone herbicide), and arguments pertaining to the equivalence of the diones and triketones as HPPD inhibitors.

Claims 18, 19, 23, and 24 are rejected under 35 U.S.C. 251 as being drawn to subject matter which is subject to the recapture rule.

It appears that pending reissue claims 18, 19, 23, and 24, drawn specifically to D+A, or encompassing D+A, represent an attempt to recapture subject matter claimed in a parent application which was deliberately canceled in order to overcome a rejection (the "recapture rule").

Art Unit: 1616

Claims 1-17 and 20-22 are also rejected under 35 U.S. C. 251 as being drawn to subject matter which is subject to the recapture rule. Insamuch as the D+triazine subject matter was also canceled in order to allow the subject matter allowed that had been indicated as being allowed, it would appear that these broader claims (1-11, 14-17, and 20-22) are also subject to the recapture rule. See MPEP 1412.02.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.



S. Mark Clardy
Primary Examiner
AU 1616

October 10, 2003